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EXAMINER

MOE, AUNG SOE

ART UNIT

PAPER NUMBER

2612

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95

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
08/610,758

Applicant(s)

Nakatsu et al.

Examiner

Aung S. Moe

Art Unit

2612



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Mar 18, 2002

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 8-35 is/are pending in the application

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 8-35 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☒ The proposed drawing correction filed on Jan 7, 1998 is: a) ☒ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some\* c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6) ☐ Other:

Art Unit: 2612

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. Claims 8-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 8 and 28, it is noted that Claims 8 and 28 contain the **functional limitation** such as “adapted to . . .” as recited in line 5 and 9 of claim 8 and line 3 of claim 28, however, it is noted there is not sufficient structure within the claim to provide for the function language such that “adapted to . . .” as recited in the claims 8/28 by the Applicant. In view of this, claims 8-35 are rejected under 112/2nd because the Functional languages of claims 8/28 render a claim improper.

### *Double Patenting*

2. Claim 25 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 26. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Art Unit: 2612

***Claim Objections***

3. Claim 31 is objected to because of the following informalities: In claim 31, line 2, please delete the word "aid". Appropriate correction is required.

***Response to Arguments***

4. Applicant's arguments with respect to claims 8-35 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

Art Unit: 2612

made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 8-17, 25-29, 31-32 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizutani et al. (U.S. 5,621,868) in view of Uekane et al. (U.S. 5,559,554).

Regarding claim 8, Mizutani '868 discloses a video printer (Fig. 1A) comprising: a video printer housing portion, a printer mechanism (i.e., this is part of the element 10) and an operation system (i.e., see Fig. 1A, the element 10; col. 3, lines 45+);

said video printer housing (10) having a connector (i.e., the element 14) being structurally adapted to mechanically and electrically attach a video camera (12) to said video printer housing portion (10);

said video camera (12) being removably connectable with said video printer housing portion (Fig. 1A), said video camera (12) being adapted to operate separate and apart from said video printer (i.e., noted from the Fig. 1A, that the video camera 12 is a conventional video camera, thus, the video camera 12 may be disconnect from the housing portion 10, so that the video camera 12 may be used separately), a display device (23) (Fig. 1B) is incorporated therein (i.e., col. 3, lines 58+);

said printer mechanism being incorporated within said video printer housing portion (i.e., Fig. 1A; col. 3, lines 45+), said printer mechanism outputting a physical reproduction of an image (i.e., Fig. 1A, the element 22), said image being captured by said video camera (12); and

Art Unit: 2612

said operation system (16) being incorporated within said video printer housing portion (10), said operation system controlling selection of said image displayed on said display device and controlling operation of said printer mechanism (i.e., Fig. 1A; the elements 16, 18 and 20; see col. 3, lines 45+).

Furthermore, it is noted that the display device (23) of Mizutani '868 is not incorporated within the video camera (12) as recited in claim 8.

However, it is conventionally well-known in the art to incorporate the display device, such as a LCD display device, within the video camera so that it would allow the camera operator to conveniently monitor the live video image data while the video camera is capturing/reproducing the video image therein as taught by Uekane '554 (i.e., see Fig. 4, the LCD display 6; col. 6, lines 5+).

In view of this, having the system of Mizutani '868 and then given the well-established teaching of Uekane '554, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Mizutani '868 by providing the display device (i.e., the LCD 6 of Uekane '554) as taught by Uekane '554 so that the size of the overall will be miniaturized and further simplify the structure of the system because such a modification as taught by Uekane '554 would eliminate the use of the separate monitor (23).

Regarding claim 9, the combination of Mizutani '868 and Uekane '554 discloses wherein said printer mechanism (10) prints said image on a printing paper (22) as a hard copy, said image being selected from a plurality of vide pictures, said plurality of video pictures being recorded by

Art Unit: 2612

said video camera as continuous motion images (i.e., noted in col. 3, lines 45+ of Mizutani '868 that the role of the video camera 12 is to provide the "video" picture signals on the display 23 so that the user may selected the desired still image from the "video" picture signals generated by the video camera 12. It is also noted that the "video" picture signals are normally considered as continuous motion images.)

Regarding claim 10, the combination of Mizutani '868 and Uekane '554 discloses wherein said operation system is used to select said image to be printed by said printer mechanism (i.e., noted from Fig. 1A of Mizutani '868 that with the use of the control panel 16, the operator may select the desired image to be printed by the printer 10).

Regarding claim 11, the combination of Mizutani '868 and Uekane '554 discloses wherein said display device includes a liquid crystal display (i.e., see col. 6, lines 5+ of Uekane '554).

Regarding claim 12, the combination of Mizutani '868 and Uekane '554 discloses wherein said image is displayed on said display device (i.e., Fig. 1B of Mizutani '868 and Fig. 4 of Uekane '554).

Regarding claim 13, the combination of Mizutani '868 and Uekane '554 discloses wherein said image that is displayed on said display device (i.e., the display 23 of Mizutani '868 and the LCD 6 of Uekane '554) is controlled by said operation system (i.e., the element 16 of Mizutani '868; see col. 3, lines 47+ of Mizutani '868).

Regarding claim 14, the combination of Mizutani '868 and Uekane '554 discloses wherein said operation system (i.e., the element 16 of Mizutani '868) includes a shuttle ring, said shuttle

Art Unit: 2612

ring providing a control to fast-forward said image displayed on said display device or to rewind said image displayed on said display device (i.e., noted the use of button 18 of Mizutani '868 as shown in Fig. 1A).

Regarding claim 15, the combination of Mizutani '868 and Uekane '554 discloses wherein said shuttle ring has a play button integrally disposed therein, said play button providing a control to play back said image displayed on said display device (i.e., noted that the control panel 16 provide the appropriate control signals by using the buttons 18 to control the video camera 12, thus, the play button must be provided so that the operator can play back a desired image on a video tape of the video camera 12).

Regarding claims 16 and 17, the combination of Mizutani '868 and Uekane '554 discloses the claimed limitations because it is noted that the control panel (1) of Mizutani '868 provides the appropriate control signals by using the buttons (18) to control the video camera (12), thus, the use of a stop button and a pause button must be provided in the control panel (16) so that the user may stop the play back operation when the play operation of the video camera (12) is needed and the user may pause the play operation when the desired image is selected for performing the still image print process therein.

Regarding claims 25 and 27, please see the Examiner's comment with respect to claim 9 as set forth above.



Art Unit: 2612

Regarding claim 26, the combination of Mizutani '868 and Uekane '554 discloses wherein said operation system is disposed on said video printer housing portion (i.e., see Fig. 1A, the elements 16 and 10 of Mizutani '868).

Regarding claim 28, the combination of Mizutani '868 and Uekane '554 discloses wherein said connector (14) includes a locking mechanism (i.e., noted that the conventional video camera 12 is coupled to the printer 10 via a cable 14, thus, the locking mechanism must be provided to secure the connection between the video camera 12 and the printer housing 10).

Regarding claim 29, the combination of Mizutani '868 and Uekane '554 discloses wherein said video printer housing (10) portion includes a signal input and output connection terminal (i.e., the connection of cable 14 to the housing 10) disposed on said video printer housing portion (10), said signals input and output connection terminal electrically connecting (i.e., it is clearly obvious from Fig. 1A that the cable 14 of Mizutani '868 is electrical connecting to the housing 10 via the input and output portion of the housing 10) said video camera (12) attached to said video printer housing portion (10) to said printer mechanism (i.e., noted the printer mechanism is located within the printer housing 10).

Regarding claim 31, the combination of Mizutani '868 and Uekane '554 discloses wherein said video camera is of a video camera with a liquid-crystal display monitor (i.e., noted the teaching of Uekane '554 as shown in Fig. 4), and said video printer (i.e., the element 10 of Mizutani '868) is operated while said image (i.e., from the camera 12 of Mizutani '868) entered into said video printer mechanism (i.e., col. 3, lines 45+ of Mizutani '868) or the manner in which

Art Unit: 2612

said printer mechanism is operated is visually confirmed on said display device (i.e., noted the use of display 23/6 for visually confirming the print image therein).

Regarding claim 32, the combination of Mizutani '868 and Uekane '554 discloses the use of video camera operation system (i.e., noted the use of operation panel 16 and the plurality of buttons 18) for displaying on said display device (i.e., the display 23/6 as shown by Mizutani '868 and Uekane '554) in a play mode, pause mode, fast-forward mode or rewind mode a video picture recorded as continuous motion images (i.e., noted that the 'video' images record/reproduce by the video camera 12 are considered continuous motion images; in col. 3, lines 35 of Mizutani '868, it is stated that the video camera 12 serves the dual roles to a video and still camera, and this implied that the video camera 12 may provide the moving video images recorded on the videotape as continuous motion images).

Regarding claim 35, the combination of Mizutani '868 and Uekane '554 discloses wherein said printer supports a video camera operation switch and a printer operation switch (i.e., Fig. 1A, the elements 18 and 20 of Mizutani '868).

Art Unit: 2612

7. Claims 18, 19, 20, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizutani '868 in view of Uekane '554 as applied to claims discussed above, and further in view of Finelli et al (U.S. 4,937,676).

- Regarding claim 18, the combination of Mizutani '868 and Uekane '554 discloses the use of the button (20) to generate the still print image selected for the video images display on the display device, thus, although it is obvious that some sort of recording medium must be provided in the printer (10) of the printer (10) of Mizutani '868 so that the selected image from the video images generated by the video camera (12) displays on the display device (23/6) may be printed by the printer (10), Mizutani '868 does not explicitly shows the recordable medium within the video printer (10).

In order to support the Examiner's position, Finelli '676 reference is provided to shows that it is conventionally well-known in the art to provide the recordable medium (i.e., Fig. 3, the element 80 of Finelli '676) along with the memory button (64) so that the image display on the display device may be stored in the memory (80) by the control of the memory button (64) and allowing the user to print the stored image in the later time period (i.e., see col. 7, lines 35+).

In view of the above, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Mizutani '868 by providing the recordable medium (i.e., the element 80) within the video printer (10) of Mizutani '868 as taught by Finelli '676, so that the user may conveniently store selected images in the video printer

Art Unit: 2612

storage unit and printing of such stored images in the later time period as desired by the operator, and such a modification clearly would improve operability of the system of Mizutani '868.

Regarding claims 19 and 20, it is noted that although Mizutani '868 shows the use of buttons (18/16) in Fig. 1A, Mizutani '868 does not explicitly shows the use of a second/input button for providing a control to access the image that has been stored within a recordable medium of said video printer.

However, the above mentioned claimed limitations are well-known in the art as evidenced by Finelli '676. In particular, Finelli '676 teaches the use of a second/input button (i.e., as shown in Figs. 1 and 3 of Finelli '676, the control panel 64 contains the second/input buttons; see col. 6, lines 65-col. 7, line 26) for providing a control to access the image that has been stored within a recordable medium (80) of said video printer (14).

In view of the above, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Mizutani '868 by providing the recordable medium (i.e., the element 80) within the video printer (10) of Mizutani '868 along with the corresponding control buttons (i.e., the second/input buttons) as taught by Finelli '676, and such a modification clearly would improve operability of the system of Mizutani '868.

Regarding claim 33, the combination of Mizutani '868 and Uekane '554 discloses that with the use of a control panel (16), the video printer (10) selected the desired image from the video images recorded on the videotapes as continuous motion images (i.e., noted that the video images recorded on the video tape of the video camera 12 is conventionally well-known as

Art Unit: 2612

continuous motion images), however, Mizutani '868 does not explicitly shows that the selected image is stored in the memory of the video printer.

As discussed above with respect to claims 18-20, Finelli '676 clearly teaches the use of memory (80) in the video printer (14) is well-known in the art, thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Mizutani '868 by providing the recordable medium (i.e., the element 80) within the video printer (10) of Mizutani '868 as taught by Finelli '676, so that the user may conveniently store selected images in the video printer storage unit and printing of such stored images in the later time period as desired by the operator, and such a modification clearly would improve operability of the system of Mizutani '868.

As for claim 34, Finelli '676 also teaches the use of input operation means (i.e., the printer control panel 64; see col. 6, lines 65-col. 7, lines 26 of Finelli '676) for entering video data indicative of a video picture in a memory (80) of the video printer (14), thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Mizutani '868 by providing the recordable medium (i.e., the element 80) within the video printer (10) of Mizutani '868 along with the corresponding input operation means (i.e., the input buttons 64) as taught by Finelli '676, and such a modification clearly would improve operability of the system of Mizutani '868.

Art Unit: 2612

8. Claims 21-24 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizutani '868 in view of Uekane '554 as applied to claims discussed above, and further in view of Kozuki et al. (U.S. 4,507,689).

Regarding claim 21, although the combination of Mizutani '868 and Uekane '554 show that the video camera (12) is connected to the printer housing (10) via a cable (14) which includes a signal input/output terminal (i.e., see Fig. 1A of Mizutani '868), it is noted that the combination of Mizutani '868 and Uekane '554 does not explicitly show the use of a plurality of guide rails as recited in present claimed invention.

However, it is cleared that with the use of cable (14), it is necessary for the operator to rearrange the cable connection by removing and inserting connectors, resulting in troublesome operations, thus, it would have been obvious to provide a connector having plurality guide rails as taught by Kozuki '689 (i.e., noted the plurality of guide rails 101/201/301 and 503 for connecting the camera with the external equipment 500) so that it would provide an easy connector which is free from the inconvenience of complicated wiring or rewiring of the cable thereof.

In view of the above, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Mizutani '868 by providing the plurality of guide rails (i.e., Fig. 1) as taught by Kozuki '689, and such a modification clearly would provide an easy connector which is free from the inconvenience of complicated wiring or rewiring of the cable thereof so that the operability of the video camera is improved (i.e., see col. 1, lines 20+ of Kozuki '689).

Art Unit: 2612

Regarding claim 22, when the system of Mizutani '868 is modified as taught by Kozuki '689, it would obviously provide the guide rails (i.e., the elements 101/503) being structurally adapted for guiding the video camera (12) onto the video printer housing portion (10).

Regarding claim 23, the combination of Mizutani '868, Uekane '554 and Kozuki '689 shows wherein the input/output terminal (i.e., noted the cable 14 of Mizutani '868 and the T1-T5 as taught by Kozuki '689) includes at least one contact member, said contact member being in electrical contact with said video camera to provide a signal between said video printer (10) and said video camera (12).

Regarding claim 24, the combination of Mizutani '868, Uekane '554 and Kozuki '689 shows wherein said input/output terminal includes at least one contact member, said contact member (i.e., T1 of Kozuki '689) being in electrical contact with said video camera (12/100) to provide power between said video printer (10) and said video camera (12/100)(col. 5, lines 1+ of Kozuki '689).

Regarding claim 30, it is noted that claim 30 substantially contains the same limitations as claims 21-24, thus, rejected for the same reasons as discussed for the claims 21-24 (i.e., see the Examiner's comment above). Furthermore, it is noted that claim 30 also recites that the guide rails guide an electrode terminal disposed on a bottom surface of the video camera, and the teaching of Kozuki '689 shows that the guide rails guide an electrode terminal disposed on the side of the camera, however, it is obvious from the Fig. 1A of Mizutani '868 that the bottom of the video camera (12) of Mizutani '868 is naturally disposed on top of the printer house (10), thus,

Art Unit: 2612

when the system of Mizutani '868 is modified by the teaching of Kozuki '689, it would have been obvious to one having ordinary skill in the art at the time the invention was made to dispose the guide rails of Kozuki '689 on a bottom of the video camera (12) to guide an electrode terminal as taught by Kozuki '689, since it has been held that rearranging parts of an invention involves only routine skill in the art.

9. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mizutani '868 in view of Uekane '554 as applied to claims discussed above, and further in view of Kamikubota (U.S. 6,091,881).

Regarding claim 33, the combination of Mizutani '868 and Uekane '554 does not explicitly state that the operation system includes a memory operation means for storing video data indicative of a video picture selected from said plurality of video pictures recorded as continuous motion images by said video camera in a memory of said video printer.

However, the above mentioned claimed limitations are well-known in the art as evidenced by Kamikubota '881. In particular, Kamikubota '881 teaches the use of a memory operation means in the operation system (i.e., Fig. 4, the element 122, 104 and 88) for storing video data indicative of a video picture selected from said plurality of video pictures recorded as continuous motion images by said video camera in a memory of said video printer (col. 5, lines 25+ and col. 9, lines 35+) so that the operator intending to reproduce the selected video picture stored in the



Art Unit: 2612

memory can adjust the tonality and other factor of the picture to be printed by the video printer (i.e., see col. 5, lines 35+).

Therefore, having the system of Mizutani '868 and then given the well-established teaching of Kamikubota '881, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Mizutani '868 as taught by Kamikubota '881, since Kamikubota '881 states at col. 5, lines 35 that such a modification would allow the operator to reproduce the selected video picture stored in the memory for adjusting the tonality and other factor of the selected video picture to be printed by the video printer thereof.

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Kinoshita '262 shows the use of a plurality of guide rails in the imaging system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Aung S. Moe** whose telephone number is (703) 306-3021. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wendy Garber**, can be reach on (703) 305-4929.

**Any response to this action should be mailed to:**

Art Unit: 2612

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**


**(703) 872-9314**, (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to  
the customer service number **(703) 306-0377**.

A. Moe

May 20, 2002

  
**AUNG S. MOE**  
**PATENT EXAMINER**